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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,537	03/15/2004	Gregory A. Haunhorst	209593-81554	1310

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EXAMINER

DUNWOODY, AARON M

ART UNIT PAPER NUMBER

3679

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/800,537	HAUNHORST ET AL.	
	Examiner	Art Unit	
	Aaron M. Dunwoody	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/16/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Claims 1-4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/23/2005.

Applicant's election with traverse of the elected invention in the reply filed on 8/23/2005 is acknowledged. The traversal is on the ground(s) that an application can only be properly restricted to one of two or more claimed inventions only if they are able to support separate patents; and examination of the entire application can be made without serious burden to the Examiner. This is not found persuasive because the reasons set forth below.

At the outset, it appears from applicant's arguments that applicant has not analyzed the examiner's action in the context of the established practice for requiring a provisional election of species as established in Chapter 800 of the MPEP. It is a well-established practice that a requirement to elect a single disclosed species is a holding by the examiner that the plural species, as claimed, are patentably distinct, i.e., capable of supporting separate patents. See MPEP 808.01 (a) and MPEP 809.02(a). If the applicant is of a different view, then applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct for restriction purposes are also not patentably distinct (i.e.,

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obvious in view of one another) for rejection purposes. Applicant's response implies that the various identified species are not considered to be patentably distinct. If such is the case, then applicant must clearly admit this on the record or point to evidence already of record.

With respect to applicant's first argument, it is noted that the examiner fully complied with the required and well-established procedures pertaining to the making of a provisional election requirement. The procedures are clearly and explicitly outlined in MPEP 809.02(a). Further, MPEP 817 clearly states that "(t)he statement in MPEP § 809.02- § 809.02(d) is adequate indication of the form of letter when an election of species is required." Further, MPEP 806.04(h) clearly states that the examiner is to group together species that are clearly unpatentable over each other. Thus, it is inherently quite evident that species not grouped together are considered to be patentably distinct from the other separately listed species.

With respect to the above and applicant's response, it is noted that applicant has failed to point out why each, or any, of these identified species are not patentably distinct.

With respect to applicant's second argument, it is noted that applicant has (1) failed to show that a coextensive search is a reason for not requiring an election requirement and (2) failed to establish that a coextensive search is present. Furthermore, applicant has failed to show that search is the overriding criteria in determining the burden imposed upon the examiner. Applicant's general allegation that search and examination of the entire application would not place a serious burden on

the Examiner fails to comply with the requirement of 37 CFR 1.111 and is wholly insufficient.

In particular, what is the basis relied upon to arrive at the conclusion that no serious burden is imposed? Is applicant alleging that the examiner would only have to consider the patentability of the generic aspects of the invention? Is applicant asserting that the various species are not patentably distinct and thus are obvious in view of one another? Nevertheless, it is extremely burdensome to have to carry out an examination, including consideration of and response to arguments, for all of the specific features of each of the multiple patentably distinct species in the same application when no patentable generic claim is indicated to be present.

Finally, applicant should note with respect to species and an election of species requirement in general that there are two and only two alternatives available and each alternative is an absolute and is mutually exclusive of the other. In particular, species can only be either (1) patentably distinct or (2) not patentably distinct. There is no middle ground between these two choices. If the species are patentably distinct, they are restrictable. If the species are not patentably distinct, then they are not restrictable. The examiner, in accordance with well established practice and procedure, has clearly indicated a position that the various species, as identified in Paper No. 20050814, are patentably distinct. Applicant's response appears to take issue with this position and thus appears to be taking the opposite position that the various species are not patentably distinct. In other words, if applicant objects to the examiner's holding that the species are patentably distinct, then it inherently follows that applicant is asserting that

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the species are not patentably distinct because that is the only alternative left. If this is correct, then applicant should clearly admit on the record that the various identified species are not patentably distinct. If this is not a correct interpretation of applicant's response, then applicant should clearly explain what the interpretation should be.

The requirement is still deemed proper and is therefore made FINAL.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5-13, drawn to a fluid connector, classified in class 285, subclass 133.11.
- II. Claims 14-28, drawn to a method of assembling a fluid connector, classified in class 29, subclass 890.14.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process which does not require creating a pilot hole in the fluid conveying member.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Bradley Diedrich on 8/30/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 5-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

The information disclosure statement (IDS) filed 9/16/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The abstract of the disclosure is objected to because it describes the non-elected invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US patent 3734112, Finney et al.

In regards to claim 5, in Figures 1, 4 and 6, Finney et al disclose a fluid connector, comprising:

In regards to claim 5, in Figures 1, 4 and 6, Finney et al disclose a fluid connector, comprising:

a fluid conveying member that includes an interior fluid passageway; and

a fitting that includes a first fluid duct and a second fluid duct in communication with the first fluid duct, the fluid conveying member sized for receipt in the first fluid duct and including an opening defined by a bushing that secures the fitting to the fluid conveying member and provides the interior fluid passageway of the fluid conveying member in communication with the second fluid duct.

In regards to claim 6, in Figures 1, 4 and 6, Finney et al disclose the bushing is a thermal formed bushing.

Note, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation is given little patentable weight.

In regards to claim 7, in Figures 1, 4 and 6, Finney et al disclose the bushing is a leak resistant joint.

In regards to claim 8, in Figures 1, 4 and 6, Finney et al disclose the bushing includes material from the fitting and the fluid conveying member.

In regards to claim 9, in Figures 1, 4 and 6, Finney et al disclose the fitting includes at least one annular sealing member positioned between the fitting and the fluid conveying member both upstream and downstream of the second fluid duct.

In regards to claim 10, in Figures 1, 4 and 6, Finney et al disclose a fluid connector, comprising:

- a fluid conveying member that includes an interior fluid passageway; and

- a fitting that includes a first fluid duct and a second fluid duct in communication with the first fluid duct, the fluid conveying member sized for receipt in the first fluid duct and including an opening defined by a retaining formation that secures the fitting to the fluid conveying member and provides the interior fluid passageway of the fluid conveying member in communication with the second fluid duct, and at least one annular sealing member positioned between the fitting and the fluid conveying member both upstream and downstream of the second fluid duct.

In regards to claim 11, in Figures 1, 4 and 6, Finney et al disclose the retaining formation is one of a collar and a bushing.

In regards to claim 12, in Figures 1, 4 and 6, Finney et al disclose the bushing is a thermal formed bushing.

In regards to claim 13, in Figures 1, 4 and 6, Finney et al disclose the bushing being a leak resistant joint.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because it illustrates the inventive concept of the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Aaron M Dunwoody
Primary Examiner
Art Unit 3679

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